

**REMARKS**

Claims 1, 3-8 and 19-32 are pending in this application. By this Amendment, claims 2 and 9-18 are canceled without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 4-6 and 8 are amended, and claims 19-32 are added. No new matter is added.

**I. Election/Restriction**

Applicants confirm the election of Group I, claims 1-8 with traverse made during a telephone conversation with Examiner Einsmann on May 15, 2003.

**II. Double Patenting Rejection**

Claims 1-5, 7 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over "claims 1 and others" of U.S. Patent 6,520,999 to Kamata et al. (Kamata). The rejection is respectfully traversed.

Applicants submit that MPEP §804 states that any obviousness-type double patenting rejection should make clear: a) the difference between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and b) the reason why a person of ordinary skill in the art would conclude that the invention defined in the claims an issue is an obvious variation of the invention defined in a claim in the patent. The disclosure may not be used as prior art.

The Office Action fails to take the steps of defining the subject matter of "claims 1 and others" in Kamata and defining the differences between those claims and the claims in the pending application. The Office Action states that "although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed process and the patented process are both directed to a process of dyeing plastic lenses wherein a computer regulates the printing of dyes on a transfer sheet, and said dyes are transferred printed onto lenses with the application of heat, using an apparatus which holds the lenses a

distance from the transfer." Accordingly, the Office Action recites similarities rather than differences between the inventions defined by the conflicting claims. Thus, the differences between the claims in Kamata and the claims in the pending application have not been identified. Furthermore, no evidence has been presented that the differences, whatever they may be, are obvious to one of ordinary skill in the art. The factual inquiries set forth in Graham v. John Deere, 338 US1, 148, USPQ459 (1966) that should be applied to establish a background for determining obviousness-type double patenting analysis are missing from the Office Action.

The obviousness-type double patenting rejection further fails to make out a *prima facie* case because it fails to provide any analysis to support the conclusion that the subject matter of "claims 1 and others" is an obvious variation of the claimed subject matter of the pending application. The Office Action fails to indicate whether "claims 1 and others" of Kamata are broader in any respect and/or narrower in any respect, or both, with respect to the claims of the pending application, or whether there is a genius-species relationship between "claims 1 and others" of Kamata and the claims of the pending application, or vice versa. Applicants are left to speculate as to the rationale for the rejection insofar as it relates to the subject matter recited in "claims 1 and others" and the subject matter in the pending application.

Applicants assert that, as admitted in the Office Action, "claims 1 and others" of Kamata do not disclose all of the features recited in the claims of the pending application. For example, Kamata does not disclose the method of dyeing a plastic lens having a curved surface, including a producing step of producing a print base body on which a graphic design is printed with a sublimatable dye by a printer under control of a computer, the printer being previously supplied with a dye, the graphic design having an area smaller than area of the curved lens surface to be dyed; a placing step of pressing the print base body against the

curved lens surface to be dyed by a pressing member so that the graphic design of the print base body is brought into nearly close contact with the curved lens surface to be dyed; and a transferring step of heating at least the pressed print base body to sublimate the dye of the graphic design so as to transfer the graphic design to the curved lens surface to be dyed. Accordingly, Applicants request the provisional rejection of claims 1-5, 7 and 8 under the judicially created doctrine of obviousness-type double patenting be withdrawn.

### **III. Claim Rejections Under 35 U.S.C. §102**

Claims 1-3 and 7-8 are rejected under 35 U.S.C. §102(b) as anticipated by EP 982432 (EP '432).

Applicants assert that EP '432 does not disclose each and every step recited in the rejected claims. For example, EP '432 does not disclose a method of dying a plastic lens having a curved surface, including a producing step of producing a print base body in which a graphic design is printed ... pressing the print body against the curved lens surface to be dyed by a pressing member ... and heating at least the pressed print base body to sublimate the dye of the graphic design.

Rather, EP '432 specifically recites that the print base body and the lens are placed in a non-contact position with each other. Additionally, EP '432 specifically requires heating the print base body in a vacuum. Thus, EP '432 does not disclose each and every feature recited in the rejected claims. Thus, Applicants respectfully request the rejection of claims 1-3, 7 and 8 under 35 U.S.C. §102(b) be withdrawn.

### **IV. Claim Rejections Under 35 U.S.C. §103**

Claim 6 is rejected under 35 U.S.C. §103(a) as unpatentable over EP '432 in view of U.S. Patent 5,052,337 to Talcott et al. (Talcott). The rejection is respectfully traversed.

Applicants assert that neither EP '432 nor Talcott, whether considered alone or in combination, disclose or suggest all of the features recited in dependent claim 6.

Additionally, Applicants submit that claim 6 is allowable for at least its dependency on claim 1 for the reasons discussed above.

Furthermore, Talcott does not overcome the deficiencies of EP '432 discussed above. Thus, the combination of references does not disclose or suggest including a step of applying a hard coat to the lens after the graphic design is transferred thereto. Accordingly, Applicants respectfully request the rejection of claim 6 under 35 U.S.C. §103(a) be withdrawn.

Claims 4 and 5 are rejected under 35 U.S.C. §103(a) as unpatentable over EP '432 in view of U.S. Patent 5,302,223 to Hale. The rejection is respectfully traversed.

Applicants submit that claims 1 and 5 are allowable for at least their dependency on claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Furthermore, the combination of references does not disclose or suggest including an input step of inputting data on the graphic design ... wherein the producing step includes printing the graphic design based on the input data to produce the print body as recited in claim 4, or the producing step includes printing the graphic design on an alignment mark based on the input position data to produce the print base body as recited in claim 5.

For example, Hale discloses a method of transferring a design onto a shirt using a thermal printer having polyester ribbon with dry ink solids. According to this method, an image captured with a video camera or a scanning device is input into a computer, the computer transmits the input image to a thermo printer, drying solids are thermally transferred onto the paper, thus providing the image on a paper. The paper provided with the image is then put on a shirt and heated, thus the image is transferred onto a shirt. Accordingly, Hale does not teach dyeing lens surface having a curved surface nor disclose alignment mark for alignment on the print base body with the lens surface to be dyed. Thus, there is no motivation or suggestion in neither of the reference to make the combination as alleged in the

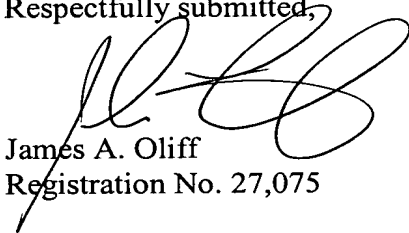
Office Action. Accordingly, Applicants respectfully request the rejection of claims 4 and 5 under 35 U.S.C. §103(a) be withdrawn.

**V. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-8 and 19-32 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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